



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/647,207 | 08/26/2003 | Ryoji Watanabe | 116872 | 1938 |
| 7590 OLIFF & BERRIDGE P. O. BOX 19928 ALEXANDRIA, VA 22320 | | | | |
| EXAMINER | | | | |
| GETANEH, MESFIN S | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2625 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 04/03/2009 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/647,207

Applicant(s)

WATANABE ET AL.

Examiner

MESFIN GETANEH

Art Unit

2625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-10 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-3 and 5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3, 5 and 7 of U.S. Patent No. 7,474,427 in view of Teraura (U.S. Patent No. 6,827,279).

Claim 1 of applicants' invention is identical to claim 3 (U.S. Patent No. 7,474,427) except

"a first parameter storage unit stores a first parameter indicating a way to form the displayed image and a formation history of the displayed image and outputs the stored first parameter to an external unit"

"a parameter reading unit for reading the output first parameter"

"an image forming unit for forming the read image on the basis of the read first parameter on a recording medium".

"a parameter writing unit for writing the read first parameter and a second parameter containing a history updated in response to the image formation on the recording medium into a second parameter storage unit included in the recording medium, wherein the history contained in the second parameter includes information indicating a previous printing of the image formed on the recording medium in an n-up print mode and information indicating the value of n, where n is a positive integer"

Regarding a first parameter storage unit of claim 1 of applicants' invention, it is nearly identical to claim 3 (U.S. Patent No. 7,474,427) of an information storage section. Both the first parameter storage unit of claim 1 of applicants' invention and information storage section of claim 3 (U.S. Patent No. 7,474,427) stores some kind of information and supplies or outputs the stored information to external. The first parameter storage unit of claim 1 of applicants' invention stores a first parameter indicating a way to form the displayed image and a formation history of the displayed image whereas the information storage section of claim 3 (U.S. Patent No. 7,474,427) stores transmission setting and a print setting regarding a printing method. Applicants' are reminded that a recitation of function may not distinguish over the prior art since an apparatus covers what a device is, not what it does. A recitation directed to the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus. See MPEP 2114, 2115; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997). Thus, the information storage section of claim 3 (U.S. Patent No.

7,474,427) is certainly capable of storing a first parameter indicating a way to form the displayed image and a formation history of the displayed image.

Regarding a parameter reading unit of claim 1 of applicants' invention, it is nearly identical to claim 3 (U.S. Patent No. 7,474,427) of an information reading section. And the same rationale as described for the first parameter storage unit of claim 1 of applicants' invention above applies here as well.

Regarding an image forming unit of claim 1 of applicants' invention, it is nearly identical to claim 3 (U.S. Patent No. 7,474,427) of an image forming device. And the same rationale as described for the first parameter storage unit of claim 1 of applicants' invention above applies here as well.

Regarding a parameter writing unit of claim 1 of applicants' invention, it is nearly identical to claim 3 (U.S. Patent No. 7,474,427) of an information writing section except the parameter writing unit of claim 1 of applicants' invention writes information into a storage unit included in the recording medium whereas claim 3 (U.S. Patent No. 7,474,427) of an information writing section writes to the information storage section. Teraura teaches RFID data recording means for recording second RFID data in second RFID tag of sheet of printing paper (col. 2, line 29-47). Within the context of both claims as a whole and Teraura, one skilled in the art would have recognized writing a stored information from the image display member to a printing sheet with RFID tag (storage unit included in the recording medium) for keeping the original settings of the image display member for next copying or printing.

Claim 2 of applicants' invention is identical to claim 3 (U.S. Patent No. 7,474,427) except

"the second parameter storage unit stores the first parameter written from the external unit and outputs the stored first parameter to the external unit". Teraura teaches RFID data recording means for recording second RFID data in second RFID tag of sheet of printing paper (col. 2, line 29-47). The RFID data recording means and the RFID data reading means are included in an image forming apparatus (external unit) of FIG. 2 and the RFID data reading means read first RFID data from the first RFID tag (col. 2, line 35-37). Examiner views the RFID data is outputted to the image forming apparatus (external unit) to be read by the image reading means. Within the context of both claims as a whole and Teraura, one skilled in the art would have recognized writing a stored information from the image display member to a printing sheet with RFID tag (storage unit included in the recording medium) for keeping the original settings of the image display member for next copying or printing.

Claim 3 of applicants' invention is rejected over the corresponding claim 5 (U.S. Patent No. 7,474,427) for the same reason as stated for claim 1 of applicants' invention above.

Claim 5 of applicants' invention is rejected over the corresponding claim 7 (U.S. Patent No. 7,474,427) for the same reason as stated for claim 1 of applicants' invention above.

Allowable Subject Matter

3. Claims 7-10 are allowed.

4. The following is an examiner's statement of reasons for allowance: The closest prior art of a record,

Teraura (U.S. Patent No. 6,827,279) discloses a sheet of printing paper has an RFID tag for receiving, storing, and transmitting data through radio wave signals. A copy machine can copy the RFID data from the RFID tag on the sheet of document paper to the RFID tag on the sheet of printing paper in addition to the image copying.

Teraura (U.S. Patent No. 6,827,279) does not disclose, teach or suggest, a computer program encoded in a computer-readable medium when executed by the computer and a method for forming an image, which is displayed on an image display member, on a recording medium, comprising:

outputting a first parameter indicating at least one of a way to form the displayed image and a formation history of the displayed image to an external unit by the image display member;

writing the read first parameter and a second parameter containing a history updated in response to the image formation on the recording medium into the recording medium,

wherein the history contained in the second parameter includes information indicating a previous printing of the image formed on the recording medium in an n-up printing mode and information indicating the value of n, where n is a positive integer.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Minami et al. (U.S. Patent No. 7,048,194) teaches a printing

paper 70 with memory element 80 storing printing information used for printing, such as a paper size and a paper type and transmitting the printing information by radio wave.

The filing date of this patent does not qualify as prior art.

Kawano et al. (U.S. Patent No. 7,385,723) teaches an image formation device including: an image reading section which reads an image from an image formation member, at which image formation member the image is formed and a hologram recording medium is mounted, associated information relating to the image being stored as a hologram in the hologram recording medium; an information acquisition section which acquires the stored associated information from the hologram recording medium; an image processing section which processes the image read by the image reading section in accordance with the associated information acquired by the information acquisition section; and an image formation section which forms an image processed by the image processing section. The filing date of this patent does not qualify as prior art.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MESFIN GETANEH whose telephone number is (571)270-3752. The examiner can normally be reached on 9:00AM-6:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark K. Zimmerman can be reached on (571) 272-7653. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mesfin Getaneh/
Patent Examiner
Art Unit 2625

/Mark K Zimmerman/
Supervisory Patent Examiner, Art Unit 2625